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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,058	11/10/2000	David Anderson	A-68531-1/RMS/JJD/SPL	4112

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Flehr Hohbach Test Albritton & Herbert LLP
Suite 3400
Four Embarcadero Center
San Francisco, CA 94111-4187

EXAMINER
CELSA, BENNETT M

ART UNIT	PAPER NUMBER
1627	

DATE MAILED: 09/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

file copy

Office Action Summary

Application No.	Applicant(s)
09/710,058	Anderson et al.
Examiner	**Art Unit**
Bennett Celsa	1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *one* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims *1-13* are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claims 1-13 are currently pending.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-9, drawn to one or more (e.g. library) of cells or vectors comprising pGFP or rGFP alone or in a fusion construct, classified in class 435, subclasses 4 and 320.1.

II. Claims 10-11 and 13, drawn to a cell line comprising a fusion construct of pGFP or rGFP and a promoter of interest and its use in screening bioactive agents for modulating a promoter of interest, classified in class 435, subclasses 240.2 and 436

III.. Claim 12, drawn to a method of screening bioactive agents capable of modulating IgE production using a fusion construct comprising pGFP or rGFP and an epsilon heavy chain, classified in class 435, subclass 69.1.

2. The inventions are distinct, each from the other because of the following reasons: Inventions I and (II or III) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case (1) the process for using the product as claimed can be practiced with another materially different product such as the use of radioisotopes or other

reporter compounds. Additionally, the product as claimed can be used in a materially different process of using that product as demonstrated in the different assays or Groups II or III; or the use of pGFP or rGFP for the syntheses of green fluorescent proteins.

3. The method Inventions II and III are independent and/or patentably distinct since the methods address different method objectives, different reaction steps, and different reagents including patentably distinct fusion constructs; and additionally have different modes of operation, different functions, or different effects.

4. Because these inventions are distinct for the reasons given above and

a. have acquired a separate status in the art as shown by their different classification; and/or

b. because the search required for the different inventions are different e.g. classification and/or bibliographic and/or sequence manual and computer searches in patent and literature databases; and/or

c. because these inventions have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Election of Species (For Groups I-III above)

5. This application contains claims directed to the following patentably distinct species (or use thereof) of the claimed invention: genetic constructs (and the use thereof) that comprise:

a. rGFP gene OR

b. pGFP gene.

Genes encoding rGFP, as compared to genes encoding pGFP, are independent and/or patentably distinct with respect to each other due to difference in structure (e.g. nucleotide sequence), chemical/biological/physical characteristics; and additionally are capable of separate manufacture and/or use; and further require different and separately burdensome manual/computer sequence and bibliographic searches in patent and literature databases.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species e.g. the rGFP gene OR pGFP gene; and further indicate the corresponding nucleotide sequence (e.g. a SEQUENCE ID) for prosecution on the merits.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

General information regarding further correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang (art unit 1627), can be reached at (703)306-3217.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1627)

September 26, 2002

BENNETT CELSA
PRIMARY EXAMINER